UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,324	01/12/2001	Joseph Kevin Gogerty	PP4811USO PHI 1320	2686

7590 06/11/2003

Heidi S. Nebel
Zarley, McKee, Thomte, Voorhees & Sease
Suite 3200
801 Grand Avenue
Des Moines, IA 50309-2721

EXAMINER
FOX, DAVID T

ART UNIT	PAPER NUMBER
1638	9

DATE MAILED: 06/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF C MMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	9

DATE MAILED:

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☑ THE PERIOD FOR RESPONSE:

a) ☐ is extended to run _____ or continues to run _____ from the date of the final rejection

b) ☑ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition , and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due in accordance with 37 CFR 1.192(a).

☑ Applicant's response to the final rejection, filed 5/27/03 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1. ☑ The proposed amendments to the claim and /or specification will not be entered and the final rejection stands because:

   a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.

   b. ☑ They raise new issues that would require further consideration and/or search. (See Note).

   c. ☑ They raise the issue of new matter. (See Note).

   d. ☑ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

   e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

   NOTE: New matter: new claims 43-45, method of transforming an ~~bred~~ plant prior to crossing - no basis in spec. New issue: claims 47+49 - is transgene the same as the gene integrated via claims 46+48, or an additional gene? (112 2nd). See attachment

2. ☑ Newly proposed or amended claims 5, 33, 41, 42 would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3. ☑ Upon the filing an appeal, the proposed amendment ☐ will be entered ☑ will not be entered and the status of the claims will be as follows:

   Claims allowed: 1-7, 20, 41

   Claims objected to: _____

   Claims rejected: 8-19, 21-40, 42

   However; would have

   ☑ Applicant's response has overcome the following rejection(s): 112 2nd claim 42, all rejections of cancelled ^ claims and claim 33

4. ☑ The ~~affidavit~~, exhibit or request for reconsideration has been considered but does not overcome the rejection because see attachment

5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficent reasons why it was not earlier presented.

☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.

☐ Other

Continuation of Item 1b: New issue: 112 2nd re claims 53-54; "the hybrid maize plant" lacks antecedent basis in claim 2. Also, methods of claims 43-50 would require new search.

Continuation of Item 1d: Failure to simplify: 112 second and both 112 first rejections remain for all claims drawn to the exemplified hybrid which has further been genetically modified, yet somehow simultaneously retains all of its characteristics before its modification (claims 8, 12, 21, 25, and new claims 51-54); and for all claims drawn to non-transformation methods of gene introgression (claims 8, 21 and new claims 46, 48, 50, and 53).

Continuation of Item 4: Wan et al cited to support doubled haploid methods is not persuasive, since the specification does not recite this term at all. Furthermore, Wan et al merely suggest the use of the technique for some type of plant breeding, but do not provide any guidance as to how this technique would be applied to breed the exemplified hybrid, its parents, or derivatives of either. The technique of Wan et al appears to be drawn to the generation of plants containing multiple combinations of alleles from each parent of the F1 hybrid, which would segregate in the pollen of the anthers produced by selfing the hybrid. The utility of these multiple combinations has not been addressed in the specification. In addition, sterility problems and flowering abnormalities were observed by Wan et al (see, e.g., page 891, column 1), and the instant specification does not provide any means to remedy these problems. It is noted that claims drawn to doubled haploid techniques were proposed to have been cancelled.

Amended claims fail to address the issue regarding the recitation that the exemplified hybrid, with a unique collection of traits, suddenly comprises additional traits, as recited in claims

8, 21, 25 and new claims 51-54. Lack of adequate written description and enablement of claims drawn to non-transgenic gene introgression, due to linkage drag, has not been addressed by amended claims. Applicant's arguments regarding these issues are largely duplicative of those previously submitted, and are not deemed to be persuasive. Deposit of the claimed hybrid and its inbred parents is sufficient to enable and describe the exemplified hybrid, but is not sufficient to enable or describe derivatives thereof which somehow simultaneously contain an additional gene while maintaining all of its desirable characteristics, and which do not contain unwanted genes linked to the introgressed gene of interest, which unwanted genes would interfere with the collection of traits that made the hybrid patentable in the first place.

DAVID T. FOX
PRIMARY EXAMINER
GROUP ~~180~~ 1638